

Remarks

After entry of the amendment, Claims 24-30 and 32-34 are pending.

Claims 1-23 and 31 have been canceled without prejudice. Claims 24-26, 30, and 32 have been editorially amended. New Claims 33 and 34 have been added.

The specification has been amended as requested by the Examiner.

No issues of new matter should arise and entry of the amendment is respectfully requested.

Election/Restrictions: Office Action at Page 2

Applicants respectfully submit that:

- Claim 25 falls within the scope of the Election/Restriction because it recites SEQ ID NO:137, which is the elected species.
- Claim 28 falls within the Election/Restriction because it encompasses SEQ ID NO:137, as evidenced by dependent Claim 29.
- Claim 32 falls within the Election/Restriction because it depends from Claim 29, which recites SEQ ID NO:137.

Applicants respectfully request that Claims 25, 28, and 32 be examined in the present application.

Sequence Compliance: Office Action at Page 3

Applicants respectfully disagree with the PTO's position. The present sequence listing does comply with 37 CFR § 1.821(a)(1) and (a)(2).

In the Sequence Listing, residues 2 and 7 in SEQ ID NO:34 are identified as "any amino acid or not present." In Formula I in the specification, residues 2 and 7 are identified as "X" and "Y".

As the PTO will appreciate X and Y are not amino acids. The specification at, e.g., Paragraph 90 in the published US application teaches that residues 2 (i.e., X) and 7 (i.e., Y) can be any amino acid:

[0090] wherein X and Y are capable of creating a bond and are independently selected residues having side chains which are chemically bonded to each other to form an intramolecular linkage such as disulfide bonds; amide bond; alkyl acids and alkyl amines which may form cyclic lactams; alkyl aldehydes or alkyl halides and alkylamines which may condensed and be reduced to form an alkyl amine or imine bridge; or side chains which may be connected to form an alkyl, alkenyl, alkynyl, ether or thioether bond. Alkyl chains may include lower alkyl groups having from about 1 to about 6 carbon atoms. In certain embodiments, the intramolecular linkage may be a disulfide, amide, imine, amine, alkyl and alkene bond. In certain embodiments, X and Y are independently selected from Ser, Asp, Glu, Lys, Orn, or Cys. In certain embodiments, X and Y are Cys and Cys. In other embodiments, X and Y are Ser and Ser. In still other embodiments, X and Y are Asp and Lys or Lys and Asp.

Residues 2 (i.e., X) and 7 (i.e., Y) are similarly defined in the specification at, e.g., Paragraph Nos. 109, 139:

[0109] X and Y are amino acids capable of creating a bond and are independently selected residues having side chains which are chemically bonded to each other to form an intramolecular linkage such as disulfide bonds; amide bond; alkyl acids and alkyl amines which may form cyclic lactams; alkyl aldehydes or alkyl halides and alkylamines which may condensed and be reduced to form an alkyl amine or imine bridge; or side chains which may be connected to form an alkyl, alkenyl, alkynyl, ether or thioether bond;

[0139] X and Y are amino acids capable of creating a bond and are independently selected residues having side chains which are chemically bonded to each other to form an intramolecular linkage such as disulfide bonds; amide bond; alkyl acids and alkyl amines which may form cyclic lactams; alkyl aldehydes or alkyl halides and alkylamines which may condensed and be reduced to form an alkyl amine or imine bridge; or side chains which may be connected to form an alkyl, alkenyl, alkynyl, ether or thioether bond;

The definitions for residues 2 and 7 in Formula I must be viewed in the context of the specification. When so viewed, Applicants respectfully submit that the Sequence Listing complies with the 37 CFR §§ 1.821 through 1.825.

Objection to Specification: Office Action at Pages 4-5

The specification has been amended as requested by the PTO in points (1)-(7), (9) and (10) in the Office Action at Pages 4-5. The PTO's point (8) is addressed above. In view thereof, Applicants respectfully request that this objection be withdrawn.

Claim Objections: Office Action at Page 5

Claims 1, 5, and 10 have been canceled without prejudice, rendering the objection moot.

Applicants response dated January 21, 2010, mistakenly indicated that Claim 29 did not read on the elected species. Since Claim 29 clearly recites the elected species (SEQ ID NO:137) it must read on the elected species. Applicants respectfully submit that Claims 24, 26, 27, and 29 meet the requirements of 37 CFR § 1.75(c) and respectfully request that the objection be withdrawn.

Rejection under 35 USC § 112, Second Paragraph

Claims 2-5, 6, 18 and 19 have been canceled without prejudice, rendering the rejection moot.

First Rejection under 35 USC § 112, First Paragraph, Enablement

Applicants traverse the rejection and submit that all the claims do satisfy the enablement requirement under 35 USC § 112, First Paragraph. Nonetheless, Claims 1-6, 8, 10, 12, 18-20 and 22 have been canceled without prejudice, rendering the rejection as to these claims moot.

Applicants do not see any reason in the Office Action at Pages 7-12 to form the basis for a rejection of Claims 24, 26, 27 and 29-31. In any event, the specification clearly describes receptor binding assays and numerous in vivo tests that can be used without undue experimentation to confirm the activity of any compound falling within the scope of the claims. See US published application at Paragraph Nos. 265-301. Thus, Applicants respectfully submit that Claims 24, 26, 27 and 29-31 satisfy 35 USC § 112, First Paragraph, and respectfully request that the rejection be withdrawn.

First Rejection under 35 USC § 112, First Paragraph, Written Description

Applicants traverse the rejection and submit that all the claims do satisfy the written description requirement under 35 USC § 112, First Paragraph. Nonetheless, Claims 1-6, 8, 10, 12, 18-20 and 22 have been canceled without prejudice, rendering the rejection as to these claims moot.

Applicants do not see any reason in the Office Action at Pages 7-12 to form the basis for a rejection of Claims 24, 26, 27 and 29-31. In any event, the specification clearly describes receptor binding assays and numerous in vivo tests that can be used to determine the functional characteristics of any peptide falling within the scope of the claimed peptides and that demonstrate that Applicants were in possession of the claimed invention at the time the application was filed. See US published application at Paragraph Nos. 265-301. Thus, Applicants respectfully submit that Claims 24, 26, 27 and 29-31 satisfy 35 USC § 112, First Paragraph, and respectfully request that the rejection be withdrawn.

Rejection under 35 USC § 102

Claims 1-4 have been canceled without prejudice, rendering this rejection moot.

Obviousness-Type Double Patenting Rejection

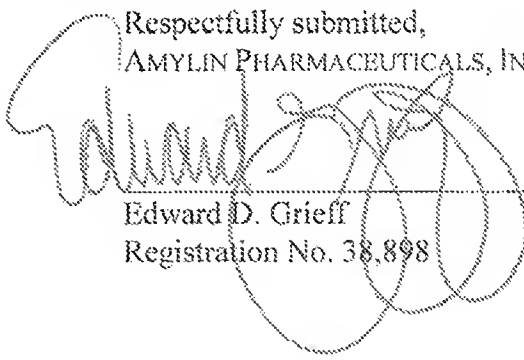
Applicants are filing herewith a Terminal Disclaimer over US Patent No. 7,399,744 and respectfully request that this rejection be withdrawn.

Conclusion

Applicants respectfully submit that Claims 24-30 and 32-34 are in condition for allowance.

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Respectfully submitted,
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